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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,038	03/29/2004	Michael F. Hoey	059US2	1447

30328 7590 09/21/2004

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/812,038

Applicant(s)

HOEY ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08202004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

A copy of the Declaration (37 CFR 1.63) for Utility or Design Application Using an Application Data Sheet (37 CFR 1.76) that was originally submitted with parent application U.S. Serial No. 09/860,648 was filed on March 29, 2004. This Declaration fails to identify the residence and post office address of each named inventor and no copy of an Application Data Sheet is in the file.

### ***Specification***

2. The disclosure is objected to because of the following informalities:
  - a. At page 2, line 7, the current status of the parent application should be provided.
  - b. At page 2, line 11, "60/243/465" should read --60/243,465--.Appropriate correction is required.

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3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Objections*

4. Claim 1 is objected to because of the following informalities: the limitation “or cortical bone near the boundary with soft tissue” recited at line 9 is redundant. Cortical bone is already recited in a limitation at line 8 of the claim. Appropriate correction is required.

5. Claim 2 is objected to because of the following informalities: in line 1, --applied-- apparently should be inserted before “signal”. Appropriate correction is requested.

6. Claim 9 is objected to because of the following informalities: the limitation “or cortical bone near the boundary with soft tissue” recited at line 11 is redundant. Cortical bone is already recited in a limitation at line 10 of the claim. Appropriate correction is required.

7. Claim 10 is objected to because of the following informalities: in line 2, --applied-- apparently should be inserted before “signal” (first occurrence). Appropriate correction is requested.

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8. Claim 17 is objected to because of the following informalities:
- a. In line 5, --applied-- apparently should be inserted before “signal”.
  - b. The limitation “or cortical bone near the boundary with soft tissue” recited at lines 9-10 is redundant. Cortical bone is already recited in a limitation at line 9 of the claim.

Appropriate correction is required.

9. Claim 18 is objected to because of the following informalities: in line 1, --applied-- apparently should be inserted before “signal”. Appropriate correction is requested.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Masreliez ('159). Masreliez teaches a method and apparatus for apical detection with complex impedance measurement. The method, apparatus, and an article of manufacture formed by software in a controller **42,50** determine whether the conductive element of a probe **46** is located adjacent to a characterized body tissue in or about a tooth. The conductive element is an electrode on a cannula or cathode probe. An electrical signal

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having a range of predetermined frequencies is applied to the conductive element; characteristics of the applied signal are determined, including an impedance of the signal through the tissue and a phase angle (col. 2, lines 8-11); and the determined characteristics are then used to determine if the probe is located adjacent to the characterized body tissue. The characterized body tissue may be bone in the vicinity of the root of the tooth, cortical bone or cancellous bone. A lip electrode 48 is also provided and the signal is passed between the electrodes. The electrical signal can be a sliding, multi-frequency testing signal (col. 3, lines 22-35).

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,760,616. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps and structural elements of the independent claims are essentially the same. The claims only differ in the recitation of the types of body

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tissue that is being characterized. Since the both the independent claims of the present application and the independent claims of the patent recite methods having substantially identical method steps and apparatus having substantially identical structural elements, differing only in intended use, the claims are not patentably distinct. Claims 1-18 of the present application generally correspond to claims 1-18 of the patent, respectively. Claim 19 of the present application generally corresponds to claim 24 of the patent. Claims 20-24 of the present application generally correspond to claims 19-23 of the patent, respectively.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kambin ('440) teaches an open surgical technique for vertebral fixation with subcutaneous fixators positioned between the skin and the lumbar fascia of a patient.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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September 17, 2004